

Remarks:

Reconsideration of the application is respectfully requested.

Applicant would like to thank the Examiner and the Examiner's SPE, Joseph Thomas, for the courtesy shown to Applicant's representatives in the interview of May 18, 2005.

Claims 75 - 96 are presently pending in the application.

Claims 70 and 72 - 74 have been canceled. New claims 75 - 76 have been added. Applicant asserts no new matter has been added by this amendment.

In item 2 of the above-identified Office Action, former claims 70 and 72 - 74 were rejected under 35 U.S.C. § 101 because the claimed invention was allegedly directed to non-statutory subject matter. More particularly, item 2 of the Office Action stated:

In order for subject matter to be considered statutory, it must produce a useful tangible, and concrete result. Exemplary claim 70 recites "a prescription created by . . ." The recited prescription is considered to be non-statutory, because it is not tangibly embodied on any media. Data structures not embodied on a computer readable media are considered descriptive material.

Applicant has canceled claims 70 and 72 - 74, thus, it is believed, mooting the present rejection. Additionally, Applicant respectfully traverses the above rejection, as applied to new claim 75. Applicant's new independent claim 75 recites as a product "**an electronic prescription**". Additionally, claim 75 recites, among other limitations:

 said electronic prescription created by said electronic prescription creation system including a program stored on a computer-readable medium, **said electronic prescription additionally being stored on a computer-readable medium;** [emphasis added by Applicant]

As such, it is believed that the product (i.e., the prescription) of claim 75 is embodied on a computer-readable medium, and thus, not descriptive.

Applicant asserts that the requirement for being tangibly embodied on a media has been satisfied and the subject invention, as now claimed, is directed to statutory subject matter and therefore not "descriptive material." As such, it is believed that the prescription of claim 75 is statutory subject matter under 35 U.S.C. § 101.

Item 2 of the Office Action further states:

Moreover, a prescription, per se is an abstract idea and is considered to be non-functional description matter even if stored upon tangible medium, because the prescription is incapable of producing a useful tangible and concrete result. Even if drafted to be tangibly embodied on a computer-readable medium, for example, the prescription data alone would fail to define any structural and functional interrelationships between the "prescription" and other elements of a computer that permit any function to be realized (See MPEP § 2106)

In light of the above, it is respectfully submitted that the claimed invention, does not have a tangible result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. § 101.

Applicant respectfully traverses the above, as applied to the instant claims. As stated above, claims 70 and 72 - 74 have been canceled, thus, it is believed, mooting the present rejection. Further, it is believed that new claim 75 overcomes the above rejection. Applicant's new claim 75 recites an electronic prescription that is, in fact capable of producing a useful, tangible, and concrete result. More particularly, among other limitations, Applicant's new claim 75 recites:

 said electronic prescription creation system being accessible by a prescriber to create said electronic prescription for prescribing a drug to treat a condition exhibited by a patient at a point-of-care **and said created electronic prescription being usable by a pharmacist to**

dispense the prescribed drug or drugs; [emphasis added by Applicant]

Based on the Applicant's claims, as currently presented, and the guidance provided in MPEP § 2106 which states "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 USC 101", Applicant respectfully submits that Applicant's claim 75 does provide a useful, tangible and concrete result. More particularly, Applicant's **electronic prescription is useful**, among other reasons, because the electronic prescription is "usable by a pharmacist to dispense the prescribed drug or drugs;" **tangible** in that, among other reasons, the pharmacist receives an electronic prescription to fulfill prescribing directions; and **concrete** in that the electronic prescription is viewable on an output screen device (see item (c) of claim 75). In view of the useful, tangible and concrete result of the claimed invention, applicant maintains that the present claims are directed to statutory subject matter and comply with the requirements of 35 USC 101.

Further, Applicant's claims, as now presented, define structural and functional interrelationship between the prescription and other elements of a computer that permit

function to be realized. Specifically, the current claims recite elements requiring that the patient condition information and drug data are being captured into the prescription by the data capture devices provided by the system. Additionally, the at least one prescribed drug is recited as being chosen from a list provided by an electronic prescription creation system, which is later recited as including a program stored on a computer-readable medium. Thus, in requiring the electronic prescription includes patient condition information and drug data that are captured into the prescription by the data capture devices provided by the system, the electronic prescription of the subject application is defined in terms of the structural interrelationship between the electronic prescription and the system used to create the electronic prescription. Thus, the electronic prescription complies with the requirement of the current Office Action in that the electronic prescription be claimed to define the structural and functional interrelationship between the electronic prescription and the computer system.

Applicant believes the claims, as now presented, are not directed to descriptive material; but produce a useful and tangible result; and define a structural and functional

interrelationship between the electronic prescription, its embodied uses/manipulation (i.e., storing the prescription on a computer-readable media) and the system that creates it. Therefore, Applicant believes that the claimed invention is statutory subject matter under 35 USC 101.

In item 4 of the Office Action, claims 70 and 72 - 74 were rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, it was alleged in the Office Action that it was unclear whether the applicant intends to claim the prescription or the prescription creation system. Applicant has canceled claims 70 and 72 - 74, thus, it is believed, mooting the instant rejection. Applicant has presented new claims which distinctly claim an electronic prescription. Thus, it is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph.

Item 4 of the Office Action further states, "limitations which define the prescription creation system, but do not appear in the resultant prescription (i.e. captured in the prescription) will not be given patentable weight." The newly presented claims expressly recite the electronic prescription including the patient identifier, drug

identifier and drug quantifier that are captured into the electronic prescription by the data capture devices of the system. Thus, the amended claims now clearly define an electronic prescription of the subject invention. Because the subject invention, as now claimed, defines an electronic prescription having specific limitations which further define resultant electronic prescription created by the prescription creation system, applicant believes the presently claimed invention complies with the requirements of 35 USC 112.

In item 6 of the Office Action, claims 70 and 72 - 74 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U. S. Patent No. 5,833,599 to Schrier ("SCHRIER").

Applicant respectfully traverses the above rejections.

Although Applicant has canceled claims 70 and 72 - 74 from the instant application, mooted the instant rejection, Applicant notes that Applicant's conception of the instant invention predates the filing of the **SCHRIER** reference. Further, Applicant pursued the claimed invention with diligence from a time prior to the filing of the **SCHRIER**

reference, until the filing of the application from which the present case claims priority. Evidence of Applicant's conception and due diligence has been set forth in connection with co-pending U. S. Patent Application Serial No. 09/941,681 ("**the '681 application**"). More particularly, on June 7, 2004, the Patent Office received Applicant's Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome a Cited Patent or Publication under 37 C.F.R. § 1.131, executed by Applicant on June 4, 2004, setting forth the prior conception of the claimed invention ("**the conception declaration**"). A copy of **the conception declaration**, with its referenced exhibits, is included herewith. Further, on January 27, 2005, the Patent Office received Applicant's Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome a Cited Patent or Publication under 37 C.F.R. § 1.131, setting forth the Applicant's diligence in pursuing the claimed invention ("**the diligence declaration**"). A copy of **the diligence declaration**, with its referenced exhibits, is additionally provided herewith.

Note that, although **the conception declaration** and **the diligence declaration** were filed in a sister case to the

present one, both declarations equally support the prior conception and diligence of Applicant with regard to the presently claimed invention. For example, new claim 75 recites, an electronic prescription, comprising:

- (A) a patient identifier;
- (B) at least one prescribed drug chosen from a list provided by an electronic prescription creation system, said list being provided based on a patient condition;
- (C) at least one drug quantifier for the prescribed drug;

said electronic prescription created by said electronic prescription creation system including a program stored on a computer-readable medium, said electronic prescription additionally being stored in a computer-readable medium;

said electronic prescription creation system being accessible by a prescriber to create said electronic prescription for prescribing a drug to treat a condition exhibited by a patient at a point-of-care and said created electronic prescription being usable by a pharmacist to dispense the prescribed drug or drugs;

said prescription creation system including,

- a) a prescription creation screen having prescriber-operable data capture devices including:
 - i) a patient identifier data capture device for capturing patient-identifying data;
 - ii) a prescribed drug data capture device for capturing prescribed drug identification data;
 - iii) at least one drug quantifier capture device for capturing drug quantification data;

- iv) a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data; and
- b) a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs;

wherein the completed prescription includes the patient condition and identification and quantification data regarding a drug prescribed by the prescriber for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices.

The **SCHRIER** reference has a filing date of April 9, 1996, and claiming priority from an application filed on **December 13, 1993**.

Applicant's claimed invention was reduced to practice, prior to **December 13, 1993**, as evidenced by Paragraph 15 of Applicant's **conception declaration**, which states:

I actually utilized the subject matter of claim 70 to write and generate an electronic prescription for viewing on a prescription creation screen and printed it out prior to December 13, 1993. The prescription was printed on a printer and included the patient condition and identification and quantification data regarding a drug prescribed by me for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices. To

the best of my knowledge a copy of this prescription would still be in memory of my original computer, which at the time of making this declaration, said computer is in storage in a location not in my present control.

Paragraph 14 of Applicant's **conception declaration** states:

14. All of the handouts and presentations referenced above in paragraphs numbered 3 through 9 illustrate that I invented the subject matter of claim 70 of the '681 Application prior to December 13, 1993. In particular, I note the following:

- a prescription creation screen having prescriber-operable data capture devices is illustrated on document nos. THB 06017 and 06036; and POL 02237, 02242, 02247, 02271, 02273, 03779, 03780, 03781, 03545, and 03548 of the enclosed materials;
- a patient identifier data capture device for capturing patient-identifying data is illustrated on document nos. THB 06010, 06012, 06015, 06017, and 06036; and POL 02243, 02247, 02271, 03545, and 03548 of the enclosed materials;
- a prescribed drug data capture device for capturing prescribed drug identification data is illustrated on document nos. THB 06010, 06011, and 06012; and POL 02246, 02247, 02248, 02261, 02271, 02273, 03779, 03789, 03781, 03545 and 03548 of the enclosed materials;
- at least one drug quantifier capture device for capturing drug quantification data is illustrated on document nos. THB 06036 and POL 02247, 02248, and 02271 of the enclosed materials;
- a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient

whereby said electronic prescription further comprises said patient condition data is illustrated on document nos. THB 06010 and 06017; and POL 02243 and 02271 of the enclosed materials;

- a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs is illustrated on document nos. THB 06010, 06011, and 06012; and POL 02236, 02246, 02248, 02261, 02273, 03545, 03548, and 03549 of the enclosed materials;
- a prescription output screen device to output a completed prescription is illustrated on document nos. THB 06012 and 06036; and POL 02246 of the enclosed materials.

As can be seen from paragraphs 14 and 15 of **the conception declaration**, Applicant had conceived of every element of present claim 75, **and reduced it to practice**, prior to the **December 13, 1993** priority date of **SCHRIER**, as shown more particularly in the following table.

Claim 75	Applicant's Conception Declaration
An electronic prescription, comprising:	"I actually utilized the subject matter . . . to write and generate an electronic prescription for viewing on a prescription creation screen and printed it out prior to December 13, 1993." Paragraph 15
(A) a patient identifier; (B) at least one prescribed drug chosen from a	". . . The prescription was printed on a printer and included the patient condition and identification and quantification data regarding a drug prescribed by me for treatment of the patient condition, the patient

Claim 75	Applicant's Conception Declaration
<p>list provided by an electronic prescription creation system, said list being provided based on a patient condition;</p> <p>(C) at least one drug quantifier for the prescribed drug;</p>	<p>condition and drug data being captured into the prescription by the data capture devices. . . ."</p> <p>Paragraph 15</p>
<p>said electronic prescription created by said electronic prescription creation system including a program stored on a computer-readable medium, said electronic prescription additionally being stored in a computer-readable medium;</p>	<p>"a prescribed drug data capture device for capturing prescribed drug identification data is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14</p> <p>" . . . The prescription was printed on a printer and included the patient condition and identification and quantification data regarding a drug prescribed by me for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices. To the best of my knowledge a copy of this prescription would still be in memory of my original computer, which at the time of making this declaration, said computer is in storage in a location not in my present control."</p> <p>Paragraph 15</p>
<p>said electronic prescription creation system being accessible by a prescriber to create said electronic prescription for prescribing a</p>	<p>"I actually utilized the subject matter of . . . to write and generate an electronic prescription for viewing on a prescription creation screen and printed it out prior to December 13, 1993. The prescription was printed on a printer and included the patient condition and identification and quantification</p>

Claim 75	Applicant's Conception Declaration
drug to treat a condition exhibited by a patient at a point-of-care and said created electronic prescription being usable by a pharmacist to dispense the prescribed drug or drugs;	data regarding a drug prescribed by me for treatment of the patient condition, . . ." Paragraph 15
said prescription creation system including,	"I actually utilized the subject matter of . . . to write and generate an electronic prescription for viewing on a prescription creation screen and printed it out prior to December 13, 1993." Paragraph 15
a) a prescription creation screen having prescriber-operable data capture devices including: i) a patient identifier data capture device for capturing patient-identifying data; ii) a prescribed drug data capture device for capturing prescribed drug identification data; iii) at least one drug quantifier	"a prescription creation screen having prescriber-operable data capture devices is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14 "a patient identifier data capture device for capturing patient-identifying data is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14 "a prescribed drug data capture device for capturing prescribed drug identification data is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14 "at least one drug quantifier capture device for capturing drug

Claim 75	Applicant's Conception Declaration
<p>capture device for capturing drug quantification data;</p> <p>iv) a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data; and</p>	<p>quantification data is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14</p> <p>"a patient condition data capture device to capture patient condition data regarding said patient condition exhibited by said patient whereby said electronic prescription further comprises said patient condition data is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14</p>
<p>b) a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs;</p>	<p>"a library of prescribable drug data accessible by one or more of said data capture devices from said prescription management screen to display multiple prescribable drugs is illustrated on [document nos. omitted] of the enclosed materials;" Paragraph 14</p>
<p>wherein the completed prescription includes the patient condition and identification and quantification data regarding a drug prescribed</p>	<p>" . . . The prescription was printed on a printer and included the patient condition and identification and quantification data regarding a drug prescribed by me for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices. . . ."</p> <p>Paragraph 15</p>

Claim 75	Applicant's Conception Declaration
by the prescriber for treatment of the patient condition, the patient condition and drug data being captured into the prescription by the data capture devices.	

Additionally, even if the new claim 75 had not been reduced to practice prior to the priority date of **SCRIER**, Applicant's **diligence declaration** shows that Applicant was diligent in pursuing claim 70 of **the '681 application**, and the same diligence would apply to the pursuit of new claim 75 of the instant application,

As such, it is believed that the **SCHRIER** reference is not properly citable against the claims of the instant application, as Applicant can prove prior conception of the claimed invention, as well as, diligent reduction to practice.

It is accordingly believed that none of the references that are prior art to the presently claimed invention, whether taken alone or in any combination, teach or suggest the features of claim 75. Claim 75 is, therefore, believed to

be patentable over the art. The dependent claim is believed to be patentable as well because it is dependent upon claim 75.

In view of the foregoing, reconsideration and allowance of claims 75 - 76 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

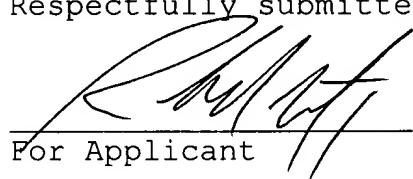
Additionally, please consider the present as a petition for a one month extension of time, and please provide a one month extension of time, to and including, November 7, 2005, to respond to the present Office Action.

The extension fee for response within a period of one (1) month pursuant to Section 1.136(a) in the amount of \$120.00 in accordance with Section 1.17 is enclosed herewith.

Please provide any additional extensions of time that may be necessary and charge any other fees that might be due

with respect to Sections 1.16 and 1.17 to the Deposit
Account of Robert M. Schwartz, P.A., No. 19-0734.

Respectfully submitted,


For Applicant

Robert M. Schwartz
Reg. No. 29,854

Robert M. Schwartz, P.A.
2445 Hollywood Blvd.
Hollywood FL 33020
Voice: 954-924-0707
Fax: 954-924-0717
email: patent@bellsouth.net